



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,021	04/18/2001	Naoyuki Kobayashi	HST10112PUSA	8135

35312 7590 04/09/2003

BROOKS & KUSHMAN P.C./ HENKEL CORPORATION
1000 TOWN CENTER TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

LEADER, WILLIAM T

ART UNIT	PAPER NUMBER
----------	--------------

1742

DATE MAILED: 04/09/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,021

Applicant(s)

KOBAYASHI ET AL.

Examiner

William T. Leader

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-8 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2003, with a certificate of mailing dated January 16, 2003, has been entered.
2. Claims 3 and 4 have been canceled. Claims 2, 9 and 10 were previously canceled. Claims 1, 5-8 and 11-24 are pending.
3. Applicant's amendment of claim 1, deleting the recitation of calcium in the nest-to-last subparagraph, has overcome the rejection of record under 35 U.S.C. 112, second paragraph.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5-8 and 11-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Applicant has amended independent claims 1 and 22 to recite treating a metal substrate "that is devoid of titanium and titanium alloys". This added negative limitation is considered to constitute new matter. *Ex parte Grassilli* (231 USPQ 393,395). Basis for the limitation in the specification as filed is not apparent. There appears to be no appreciation on the part of the inventors at the time the application was filed that the substrate treated should be devoid of titanium and titanium alloys. To the contrary, the specification teaches that titanium is one of the metal substrate materials that *can* be used in the present invention. See page 5, lines 22-26. At page 5 of the Remarks, applicant states that the substrates used are "steel (Type S34D, austenitic stainless steel (Type SUS304, and aluminum (Type A6061). The negative limitation that the substrate is devoid of titanium and titanium alloys is not an equivalent limitation to the positive recitation of the metals discussed in the Remarks.

Art Unit: 1742

8. Claims 1, 5-8 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al in view of Shimakura et al and Witte for the reasons given in the previous office action and in view of the following comments.

9. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al for the reasons given in the previous office action and in view of the following comments.

10. Applicant has amended independent claims 1 and 22 to recite that the metal substrate is devoid of titanium and titanium alloys. Sonoda is applied as in the previous office action and is directed to the treatment of titanium and titanium alloys to produce a surface with improved lubricity and cold working characteristics. The reference to titanium alloys in Sonoda is taken broadly and suggesting alloys in which titanium is the major component and also alloys in which titanium is a minor component. Thus, Sonoda suggests that the beneficial results of the process may be obtained on workpieces which contain only a small amount of titanium with the balance being another metal. In view of this broad teaching, it would have been obvious to have applied the process of Sonoda to metal workpieces other than titanium or titanium alloy workpieces because the beneficial properties of improved lubricity and cold working characteristics would have been expected to be obtained.

Art Unit: 1742

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 703-308-2530. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

WL
William Leader
April 3, 2003

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700